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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,583	11/18/2003	Deborah Overoyen	16356-002001	4738

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EXAMINER

HOFFMAN, SUSAN COE

ART UNIT	PAPER NUMBER
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1655

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/715,583

Applicant(s)

OVEROYEN, DEBORAH

Examiner

Susan Coe Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 16, 19-21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 16, 19-21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 22, 2006 has been entered. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 5-15, 17-18, 22, and 25-26 have been cancelled.
3. Claims 1-4, 16, 19-21, 23, and 24 are currently pending.

Claim Rejections - 35 USC § 102

4. Claims 16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by prior art admitted by applicant in the specification for the reasons set forth in the previous Office action for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the specification does not admit that *Salvadora persica* is known to be in the forms claimed in amended claims 16 and 21. However, this is not persuasive because *S. persica* sticks are reasonably considered to be a toy because companion animals such as dogs frequently use sticks as toys. In addition, the *S. persica* sticks

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are also considered to be a medicament because the sticks are used for a medical purpose, i.e. cleaning the teeth. Thus, claims 16 and 21 are still considered anticipated.

5. Claims 16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Almas (Journal of Contemporary Dental Practice (August 2002), vol. 3, no. 3, pp. 1-10) for the reasons set forth in the previous Office action.

Applicant did not specifically address this rejection in the response. Almas is still considered to teach the claimed invention as set forth in the amended claims. *S. persica* sticks as taught by Almas are reasonably considered to be a toy because companion animals such as dogs frequently use sticks as toys. In addition, the *S. persica* sticks are also considered to be a medicament because the sticks are used for a medical purpose, i.e. cleaning the teeth. Thus, claims 16 and 21 are still considered anticipated.

6. Claims 16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Almas et al. (Biomedical Letters (1999), vol. 60, pp. 71-75) for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that Almas does not teach *S. persica* in the forms claimed in amended claims 16 and 21. However, this is not persuasive because *S. persica* sticks are reasonably considered to be a toy because companion animals such as dogs frequently use sticks as toys. In addition, the *S. persica* sticks are also considered to be a medicament because the sticks are used for a medical purpose, i.e. cleaning the teeth. Thus, claims 16 and 21 are still considered anticipated.

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7. Claims 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat.

No. 5,009,886 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the reference does not teach the claimed invention because the reference teaches microfibers or micro-sized particles of *S. persica* rather than solvent extracts as set forth in specification. However, as discussed in MPEP section 2111.01, it is improper to import limitations from the specification into the claims. "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). Thus, the term "extract" is given its broadest reasonable interpretation which is considered to encompass mechanical extracts from *S. persica* including microfibers and micro-sized particles because these are extracted from the plant. In addition, the reference does specifically teach using a liquid extract from the wood of the plant (see Example 2). Thus, the reference also anticipates a solvent extract from the plant.

Claim Rejections - 35 USC § 103

8. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Almas (Journal of Contemporary Dental Practice (August 2002), vol. 3, no. 3, pp. 1-10) in view of US Pat. No. 5,033,410 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant also argues that there is no motivation to combine the references together to produce an exogenously flavored *S. persica* stick. However, as discussed in the previous Office action, US '410 teaches using flavored chew items for animals to clean their teeth. Any desirable flavor can be used. Specific example of flavorings include beef and cod liver oil (see paragraph spanning columns 1 and 2). Thus, it was known in the art at the time of the invention to coat teeth cleaning items with flavorings. A person of ordinary skill in the art would reasonably expect that the *S. persica* sticks taught by Almas could be used for animals and would be more attractive to the animals if coated with desirable flavors. Therefore, it would be an obvious modification to coat the chewing stick taught by Almas with flavors desirable for animals as taught by US '410. Furthermore, it is well known in the art that it is beneficial to treat teeth with antibiotics, vitamins, and nutrients. This is discussed by Almas on page 3. Thus, it would also be considered obvious to add these to the dental cleaning stick taught by Almas because all of the products are known to be used for the same purpose.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

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time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,009,886 in view of US Pat. No. 5,033,410 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant also argues that there is no motivation to combine the references together to produce an exogenously flavored *S. persica* stick. However, as discussed in the previous Office action, US '410 teaches using flavored chew items for animals to clean their teeth. Any desirable flavor can be used. Specific example of flavorings include beef and cod liver oil (see paragraph spanning columns 1 and 2). Thus, it was known in the art at the time of the invention to coat teeth cleaning items with flavorings. A person of ordinary skill in the art would reasonably expect that the *S. persica* sticks taught by US '886 could be used for animals and would be more attractive to the animals if coated with desirable flavors. Therefore, it would be an obvious modification to coat the chewing stick taught by US '886 with flavors desirable for animals as taught by US '410. Furthermore, it is well known in the art that it is beneficial to treat teeth with antibiotics, vitamins, and nutrients. This is discussed by US '886 in the examples.

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Thus, it would also be considered obvious to add these to the dental cleaning stick taught by US '886 because all of the products are known to be used for the same purpose.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. Claims 16, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,009,886 in view of US Pat. No. 4,145,447 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the references do not teach using *S. persica* products that are to be used for companion animals. However, as discussed in the previous Office action, US '447 teaches using a chewable food, treat, snack or toy are known to be used for oral care products. US '447 teaches adding oral care medicaments to these forms (see abstract and column 3). Thus, a person of ordinary skill in the art would reasonably expect that the *S. persica* extract of US '886 could be incorporated in oral care products as taught by US '447. This reasonable expectation of success would motivate an artisan of ordinary skill to make such a modification to the references. Thus, the product taught by the combination of the references is considered to be structurally the same as the claimed product.

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11. Claims 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,009,886 in view of US Pat. Pub. No. 2002/0054858.

The teachings of US '886 are discussed above. The reference does not specifically teach impregnating the bristles of a toothbrush with the *S. persica* extract. US '858 teaches coating toothbrush bristles or impregnating the bristles with oral hygiene products. Thus, it was known in the art at the time of the invention to coat or impregnate toothbrush bristles with oral hygiene products. An artisan of ordinary skill in the art would reasonably expect that the oral care *S. persica* extract taught by US '886 could be coated on a toothbrush or impregnated onto bristles in order to form an oral care product. This reasonable expectation of success would motivate the artisan to modify the references to arrive at the product claimed by applicant.

Double Patenting

12. Claims 21, 23, and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/872,689 for the reasons set forth in the previous Office action.

Applicant has requested that this rejection be held in abeyance until allowable subject matter is indicated. For the time being, this rejection is maintained.

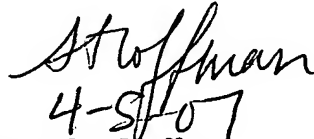
13. No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


4-5/07
Susan Coe Hoffman
Primary Examiner
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